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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,226	12/19/2001	Albert J. Robichaud	PH-7306	4378

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EXAMINER

RAO, DEEPAK R

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,226

Applicant(s)

Robichaud et al.

Examiner

Deepak Rao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 24, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 ☒ are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 ☒ are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claims 1-15 are pending in this application.

Election/Restriction

Applicant's election with traverse of Group II, claims 1-15, drawn to compounds of formula (I) wherein T^{ag} is of formula 3) or 11), in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the restriction is improper. This is not found persuasive because the compounds of Groups I-VIII are drawn to structurally dissimilar compounds which are not art recognized equivalents. They are structurally dissimilar such that a reference anticipating a compound of Group I may not render the compounds of Groups II-VIII obvious or vice-versa. 37 CFR 1.141(a) provides that two or more independent and distinct inventions may not be claimed in one application, whether or not the misjoinder occurred in one claim or more than one claim. Restriction is going to be exercised where independent and distinct inventions are presented in one Markush grouping. Independent means when the compound is being made and/or used alone, not in combination with other compounds of the Markush expression. Restriction is considered proper in Markush claims where the members are so diverse and unrelated that a prior art reference anticipating the claim with respect to one of the members, would not render the claims obvious under 35 U.S.C. 103 with respect to the other members. Therefore, what should be considered for patentable distinctness is the compound as a whole. Each of the groups are

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classified separately and further, the compounds of Groups I-VIII require separate searches in the literature and therefore, it is burdensome for the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-15 (in part) drawn to compounds of formula (I) wherein T^{ag} is formula 1) - 2) or 4) - 10) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

Applicant's election of the species as identified in page 1 of paper no. 7 is acknowledged. As the elected species was not found in the prior art, the search was expanded to the elected genus, i.e., to the compounds of formula (I) wherein T^{ag} is formula 3) or 11).

Specification

The disclosure is objected to because of the following informalities:

On page 34, line 30, the specification states "... compounds of Formula (I) and (II)", however, there is no disclosure of '**Formula (II)**' any where in the specification. The terms is also recited on page 34, lines 33 and 36; page 37, line 18; and page 40, lines 3 and 7.

Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites formula (I) to be “ $S^{ag} - T^{ag}$ ” wherein S^{ag} is defined to be R^A or R^B and T^{ag} is a group selected from formulae 1) to 11) as disclosed on pages 53-55. The groups of formula 1) to 11) however have a substituent R^A or R^B attached to the rings, therefore, it is confusing whether the groups disclosed as formula 1) to 11) are representing the fragment T^{ag} or formula (I) itself. The specification does not provide any help regarding this. As the elected species has only one substituted phenyl substituent attached to the tricyclic ring system, it appears that only one R^A or R^B is intended to be attached to the rings of groups 1) to 11). Appropriate clarification or correction is required.

Allowable Subject Matter

Claims 1-15 would be allowable if rewritten or amended, limiting to the elected invention of Group II and to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action. The closest reference of record, CA 2,097,465 teaches pyrazinoindole compounds, however, the reference does not teach or fairly suggest an aryl or aryl amino substituent as required by the instant claims.

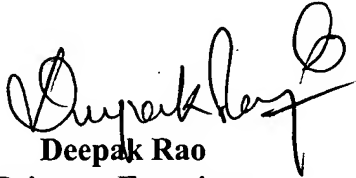
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (703) 305-1879. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (703) 308-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


Deepak Rao
Primary Examiner
Art Unit 1624

May 21, 2003